

## Office Action Response for C-THRU (Serial No. 85/914,602)

In the present Office Action, the Examining Attorney has preliminarily refused registration of Applicant's mark C-THRU ("Applicant's Mark") for "orthodontic brackets" in International Class 10, under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), on the ground that it merely describes a feature of Applicant's goods, namely, that Applicant's orthodontic brackets are see thru. Applicant respectfully disagrees with the Examining Attorney's finding and requests that the descriptiveness refusal be withdrawn for the reasons discussed below.

### A. The Examining Attorney's Evidence Does Not Support a Descriptiveness Refusal

It is the burden of an examining attorney to prove that a term is merely descriptive. *In re Merrill, Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). The Examining Attorney has not met this burden in the present case, as the evidence provided in the Office Action does not support a descriptiveness refusal.

In order to find that Applicant's Mark merely describes a feature of Applicant's goods, the Examining Attorney dissected Applicant's Mark into individual components, rather than considering Applicant's Mark in its entirety. The Examining Attorney provided information showing the individual component "C" can stand for the word "see," together with a dictionary definition of "see" as "to perceive with the eyes." The Examining Attorney also provided information showing the individual component "THRU" can be an alternate spelling of the word "through," together with a dictionary definition of "through" as "going in or staring at one side and coming out or stopping at the other side of." However, these definitions are inadequate and limited in nature, and do not prove that Applicant's Mark is merely descriptive. The letter "C" appearing in Applicant's Mark could stand for other words with different definitions; likewise, the term "THRU" or "through" has many different definitions, not just the one provided by the Examining Attorney. As a result of the various definitions that could exist for the individual component "C," and separately for the individual component "THRU," Applicant's Mark *in its entirety* could convey to purchasers many discernible meanings, other than the one suggested by the Examining Attorney.

Even if the limited definitions provided by the Examining Attorney were in fact accurate for each of the individual components of Applicant's Mark, such evidence is still insufficient to support a descriptiveness refusal in the present case because the mark could convey other significant and discernible meanings or suggestions in relation to Applicant's goods. *In re Health Facts, Inc.* (TTAB 2001) is instructive on this point. In *Health Facts*, the Examining Attorney refused registration of A MAN'S FACE for "non-medicated skin care products, namely, lotions, astringents, balms, creams, cleansers and powders" on the ground that the mark merely described the intended area of use of the goods. As evidence that the mark immediately conveyed to purchasers that the recited goods were to be used on a man's face, the Examining Attorney provided dictionary definitions of the individual components of the mark as well as excerpts from various periodicals. The Examining Attorney stated that the meanings of the individual components were understandable to purchasers and had no double meaning in relation to the recited goods. Despite the evidence of record, the Trademark Trial and Appeal Board ("TTAB") disagreed with the Examining Attorney's position and found that the mark, when

considered *in its entirety*, was suggestive rather than merely descriptive of the recited goods. In reversing the descriptiveness refusal, the TTAB stated that:

[A]t a minimum we have doubt that applicant's mark immediately conveys *only* that its goods are to be used on a man's face, as contended by the Examining Attorney, and thus has no other significant and discernible meaning or suggestion in relation to applicant's goods. In view thereof, we resolve such doubt, in accordance with the Board's practice, in favor of publication of applicant's mark for opposition.

*Health Facts* at 6 (*emphasis in original*). Likewise, in the present case, the Examining Attorney's evidence in the form of dictionary definitions of the *individual components* of Applicant's Mark does nothing to prove that Applicant's Mark *in its entirety* immediately conveys *only* that Applicant's orthodontic brackets are see thru, as suggested by the Examining Attorney. Applicant's Mark, when considered in its entirety, is suggestive rather than merely descriptive because it could convey other significant and discernible meanings or suggestions in relation to Applicant's goods.

In addition to the dictionary definitions of the individual components of Applicant's Mark, the Examining Attorney provided printouts from five websites allegedly showing that "C-THRU" is commonly used to refer to orthodontic brackets that one can look at on one side and see through to the other side. However, these printouts do not show any such use. Instead, they show use of the wording "see through" and/or "see-through" (not "C-THRU") to refer to orthodontic braces or aligners (not orthodontic brackets) that are nearly invisible or clear, as follows:

- The first printout shows use of the wording "see through" and "see-through" to refer to orthodontic *braces* that are nearly invisible (i.e., "Harnessing the latest in 3D imaging software, dentists can now offer Invisalign braces which are virtually see through..."). The wording is *not* used to refer to orthodontic *brackets* whatsoever, as Invisalign braces do not include brackets or wires. Moreover, the wording is used by a third party in London, which is irrelevant to prove descriptiveness in the minds of purchasers in the United States.
- The second printout shows use of the wording "see-through" to refer to orthodontic *braces* that are nearly clear (i.e., "Clear braces are made of pure monocrystalline sapphire, which makes the clear braces practically see-through, except for the arch wire."). There is *no* mention of orthodontic *brackets* whatsoever in connection with the wording.
- The third printout shows use of the wording "see-through" to refer to orthodontic *braces* that are nearly clear (i.e., "The brackets are made of pure monocrystalline sapphire, which makes the clear braces practically see-through - except for the arch wire."). Although there is some mention of orthodontic *brackets*, the wording is used *only* to refer to orthodontic *braces*.

- The fourth printout shows use of the wording “see-through” to refer to orthodontic *braces* that are nearly clear (i.e., “Clear braces are nearly see-through because they use brackets that are made of monocrystalline sapphire.”). Although there is some mention of orthodontic *brackets*, the wording is used *only* to refer to orthodontic *braces*.
- The fifth printout shows use of the wording “see through” to refer to orthodontic *aligners* that are nearly clear (i.e., “A set of see through-plastic aligners are constructed.”). The wording is *not* used to refer to orthodontic *brackets* whatsoever, as clear aligners do not include brackets or wires.

As illustrated above, the printouts provided by the Examining Attorney do not show any use of “C-THRU” to refer to orthodontic brackets that one can look at on one side and see through to the other side, making such evidence insufficient to support a descriptiveness refusal in the present case. And, importantly, simply searching the Internet for third party references to orthodontic hardware that is in fact see through and is described as such says nothing whatsoever about the descriptive versus suggestive nature of Applicant’s Mark as used on Applicant’s goods.

*In re Roche Diagnostics Corporation* (TTAB 2002) is instructive and demonstrates how the TTAB decides cases where the Examining Attorney’s evidence does not support a descriptiveness refusal. In *Roche*, the Examining Attorney refused registration of D-TECTOR for “medical apparatus, namely, an optical screening device for noninvasively measuring optic lens fluorescence from glycosylated end products and glycosylated proteins in the eye[s] of individuals potentially having diabetes, primarily for use by optometrists and ophthalmologists” and “printed instructional materials and brochures relating to diabetes” on the ground that the mark was the phonetic equivalent of the word “detector,” which described the nature and purpose of the goods, namely, to *detect* the amount of optic lens fluorescence in the eye. As evidence that the mark was descriptive, the Examining Attorney provided a dictionary definition of “detector” and printouts from the Nexis database related to detecting diseases. The TTAB reversed the refusal because it found the Examining Attorney’s evidence did not prove that the mark D-TECTOR conveyed an immediate idea of a *primary* purpose of applicant’s medical apparatus, which was to *measure* the amount of optic lens fluorescence in the eye (*not* to detect the amount). This finding is on point and should be applied to the present case as well. Just as D-TECTOR did not convey the primary purpose of Roche’s medical apparatus, neither does C-THRU convey the primary purpose of Applicant’s orthodontic brackets. The limited definitions and website printouts provided by the Examining Attorney do not prove that Applicant’s Mark conveys an immediate idea of a *primary* feature of Applicant’s orthodontic brackets, which is to help align teeth (*not* to be seen through). Therefore, the descriptiveness refusal should be withdrawn.

#### B. Applicant’s Mark Does Not Merely Describe a Feature of Applicant’s Goods

“A term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Moreover, the immediate idea must be conveyed forthwith with a “degree of particularity.” *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978). A term is suggestive, however, if a multi-stage reasoning process, or the

utilization of imagination, thought, or perception, is required to determine what attributes of the services are indicated by the term. *See, e.g., In re Abcor Development Corp.*, 588 F.2d at 218. In the present case, Applicant's Mark does not merely describe a feature of Applicant's goods because it does not immediately convey any one thing with a degree of particularity. In this way, Applicant's Mark is suggestive at best, rather than merely descriptive.

The letter "C" appearing in Applicant's Mark could stand for numerous words with different definitions in relation to Applicant's orthodontic brackets. For example, in the dental industry, the letter "C" can stand for many different things, such as "canine teeth," "coarse," "complete upper denture," "complete lower denture," "crown," etc. *See* the definition of "dental formula" and pages from the American Dental Association's Dental Abbreviations, Symbols and Acronyms attached as Exhibit A and made a part hereof by this reference.

Similarly, the term "THRU" appearing in Applicant's Mark could be an alternate spelling of the word "through," which has many different definitions. For example, in relation to Applicant's orthodontic brackets, the term can be defined as "over the whole surface or extent of," "exposure to a specified set of conditions," "a period of time," "completion," etc. *See* the definition of "through" attached as Exhibit B and made a part hereof by this reference.

The individual components of Applicant's Mark might suggest several non-descriptive meanings as applied to Applicant's goods. This creates a double entendre that will only be understood by purchasers after a multi-stage reasoning process. It is only after reflection, or some operation of the imagination, that purchasers will be able to determine a primary feature of Applicant's goods. This multi-stage reasoning process makes Applicant's Mark suggestive rather than merely descriptive. *In re Regal Discount Securities, Inc.* (TTAB 2000) is instructive on this point. In *Regal*, the Examining Attorney refused registration of E-OPTION for "stock brokerage services in securities, including the buying and selling of stocks, options and mutual funds" on the ground that the mark was merely descriptive of the recited services. Applicant argued that the mark was not merely descriptive because, in part, the term "OPTION" in the mark created a double entendre, as applied to the recited services. That is, the term "OPTION" might refer to the financial securities known as "options," but it also refers to the fact that applicant's customers have the "option" of trading conventionally or electronically. The TTAB agreed with applicant and reversed the descriptiveness refusal.

In connection with applicant's services, this second meaning of E-OPTION would be understood by customers, but only after they had undertaken a multi-stage reasoning process. That is, the purchaser must recognize that "option" has a general meaning ("choice") in addition to its specific meaning in the financial securities field, that applicant renders its services via both electronic and conventional means, and that the customer has the option of choosing either of those means in his or her dealings with applicant. The necessity of this multi-stage reasoning process makes applicant's mark suggestive rather than merely descriptive.

*Regal* at 7. Likewise, in the present case, the numerous non-descriptive meanings suggested by the individual components of Applicant's Mark create a double entendre, as applied to

Applicant's goods. Therefore, Applicant's Mark does not merely describe a feature of Applicant's goods, but instead is suggestive.

*In re Oldcastle Glass, Inc.* (TTAB 2004) is also instructive and on point. In *Oldcastle*, the Examining Attorney refused registration of E•FAB (also referred to as E.FAB or E-FAB) for "glass, namely, glass panels; tempered glass panels for building purposes" on the ground that the mark was merely descriptive of the identified goods. The Examining Attorney provided various types of evidence in support of the refusal, including a dictionary definition of "fab" as "fabrication: building a shed of metal fab," information showing the letter "E" can stand for "electrical" or "electronic," and excerpts of articles showing that "e" and "e-" can be a prefix meaning the product or service is available via the Internet. Based on this evidence, the Examining Attorney argued that the mark was descriptive because it stood for "electronic fabrication" and applicant's glass products must be viewed as being produced electronically because purchasers' specifications for the goods were sent to applicant via the Internet. While applicant's goods might be viewed as being electronically ordered fabricated glass products, the TTAB found that the evidence of record left some doubt as to how purchasers would perceive the mark. More specifically, some of the webpages provided by the Examining Attorney were not probative on whether "electronic fabrication" is used in the industry to describe a process for making glass products, as the webpages focused on a software product for managing an "electronic fabrication of micro and nanoscale devices." Also, the evidence of record did not confirm whether purchasers were more likely to consider "FAB" to mean "fabrication" or "fabulous." Therefore, the TTAB reversed the refusal because any doubt about whether a mark is descriptive must be resolved in favor of the applicant.

Similarly, in the present case, while Applicant's goods might be viewed as orthodontic brackets that are see through (as suggested by the Examining Attorney), the evidence of record leaves some doubt as to how purchasers will perceive Applicant's Mark. More specifically, the printouts provided by the Examining Attorney do not show "C-THRU" being used in the dental industry to refer to orthodontic brackets whatsoever, as they focus on use of the wording "see through" and/or "see-through" (none of the examples has any use of "C-THRU") to refer to orthodontic braces or aligners (not orthodontic brackets). Also, the evidence of record does not confirm whether purchasers are more likely to consider the individual component "C," and separately the individual component "THRU," as having the exact definitions provided by the Examining Attorney, or one of the various other definitions provided by Applicant. As such, the refusal should be withdrawn in order to resolve any doubts of descriptiveness in favor of Applicant.

The U.S. Patent and Trademark Office's ("USPTO") previous treatment of "C-THRU" in certain cases is yet another indication that some doubt exists about whether Applicant's Mark is merely descriptive. A search of the USPTO database revealed numerous third party registrations on the Principal Register for "C-THRU" covering a variety of goods and services where the registrant did not claim acquired distinctiveness as to the mark. Some examples of these third party registrations are as follows:

- C-THRU for retail store, retail catalogue, and retail on-line services featuring window film for residential and commercial buildings (Reg. No. 3,117,856)

- C-THRU for janitorial supplies, namely glass sprays and light duty all-purpose cleaners (Reg. No. 3,073,088)
- C-THRU for various tobacco products, accessories, and smoking articles (Reg. No. 3,423,826)
- C-THRU for perfumery (Reg. No. 3,704,308)
- C-THRU for flashlights and portable electronic lanterns (Reg. No. 3,138,436)
- C-THRU for various ancillary surgical table equipment (Reg. No. 3,976,194)

See U.S. Certificates of Registration for the above-listed marks attached as Exhibit C and made a part hereof by this reference. In all of these situations, it presumably would be possible to imagine some aspect in which the words “see-through” could apply to the product or service (a window of a retail store can be seen through, a glass spray helps glass become see through, smoke exhaled when using tobacco products is see through, etc.) But, just as is the case for Applicant’s Mark, being see through is not the *primary* feature of any of these goods or services, nor immediately understood for any of the underlying products or services.

*In re Donell, Inc.* (TTAB 2004) illustrates how the TTAB decides cases where the USPTO’s previous treatment of the mark at issue indicates that the mark is not merely descriptive. In *Donell*, the Examining Attorney refused registration of the mark BOO BOO CREAM for “a topical wound healing agent in the form of a cream for skin wounds, insect bites and other skin irritations” on the ground that it was merely descriptive of applicant’s goods. Applicant argued that the mark was not merely descriptive because, in part, “BOO BOO” had been treated as a suggestive term by previous examining attorneys. To support this position, applicant pointed to five prior third party registrations for marks containing “BOO BOO” where a disclaimer of the wording was not required. While third party registrations are not conclusive on the issue of descriptiveness, the TTAB found that the previous treatment of “BOO BOO” as suggestive raised doubts as to whether the wording was merely descriptive of applicant’s goods. Thus, the TTAB reversed the descriptiveness refusal accordingly. This finding is on point and should be applied to the present case as well. The USPTO’s previous treatment of “C-THRU” in certain cases raises doubts as to whether Applicant’s Mark is merely descriptive. While Applicant understands that third party registrations are not conclusive on the issue of descriptiveness, such registrations still establish that the USPTO regularly registers “C-THRU” on the Principal Register for a variety of goods and services. As such, the Examining Attorney’s descriptiveness refusal should be withdrawn accordingly.

### C. Conclusion

As discussed above, the Examining Attorney’s evidence does not support a descriptiveness refusal in the present case, nor does Applicant’s Mark merely describe a feature of Applicant’s goods. Moreover, any doubts as to the descriptiveness of Applicant’s Mark must be resolved in favor of Applicant. See, e.g., *In re Conductive Systems, Inc.*, 220 USPQ 84, 86 (TTAB 1983); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972); *In re Shutts*, 217 USPQ 363 (TTAB 1983). Therefore, Applicant respectfully requests that the Examining Attorney withdraw the descriptiveness refusal and approve Applicant’s Mark for publication.